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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,273	02/07/2002	Daryl L. Roberts	M419.12-0031	2452

27367 7590 06/02/2005

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EXAMINER

SIEFKE, SAMUEL P

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,273

Applicant(s)

ROBERTS ET AL.

Examiner

Samuel P. Siefke

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 11-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/25/02, 9/10/02.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I in the reply filed on 4/18/05 is acknowledged. The traversal is on the ground(s) that claims 11-29 have been amended and are believed to be directed to the same process as claims 1-10. This is not found persuasive because claim 11 claims a plurality of separate impactor compartments which include impactor cups a common impactor cup manifold. Claim 1 does not required impactor cups or a common impactor cup manifold. This is still recognized as subcombination combination restriction groups.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what relationship the compartment

Art Unit: 1743

manifold, the supported compartment and the service manifold have. Yes they are all parts of an impactor but they do not define structural relationship with each other.

Claim recites the step of adding a solution for dissolving material in the compartments. It is unclear where the solution is added.

Where is the service manifold in relationship to the compartment manifold and supported compartment when they are moved?

The step of "simultaneously moving the compartment manifold and service manifold as a unit under power to enhance dissolution of particles". How do the parts move if they are removed from the impactor when they are with the service manifold?

How are the particles classified into separate size ranges? The separate impactor compartment is singular not plural. Claim 1 is in singular form, one impactor compartment, one compartment manifold, one supported compartment and one service manifold.

Claim 1 is a method for recovering of processed particles, not a method for classifying particles because the impactor is disassembled and the parts are washed with a solution to dissolve the particles that are stuck on the parts of the impactor.

The only method steps in claim 1 are moving, adding and simultaneously moving. The claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Claim 11 is a better representation of positively reciting steps, for exemplary purposes.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,723,568. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application requires disassembling the impactor to remove the classified particles whereas 6,723,568 injects a fluid into the impactor into each of the impactor compartment. It would have been obvious to one having an ordinary skill in the art to require disassembly of an impactor for removal of classified particles, i.e. injecting a solution to help dissolve trapped particles into each compartment then recovering the solution, in order to avoid solvent contamination of the impactor mechanical components.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-10** are rejected under 35 U.S.C. 102(e) as being anticipated by Call et al. (USPN 6,267,016).

Call discloses a method for recovering classified particles that comprises moving a fluid that comprises a plurality of impaction surfaces (col. 4, lines 38-47; impeller vanes 24, plate 22, annular plate 26, inner surface 74 of cavity 14); supporting the plurality of impactor components in a support and are enclosed (the housing 12 defines an internal cylindrical cavity 14 which encloses all the impaction surfaces and components); injecting a solvent solution into the enclosure containing an impactor surface (col. 2, line 66 – col. 3, line 8); agitating (washing) the solvent applied by moving (rocking) the support so that a plurality of the impactor surfaces are agitated simultaneously (refer to the collector and fan, which when the fan is on the (col. 7, lines 10-28) the rotational speeds which agitates the solvent applied by moving (rocking) the support (fan) so that a plurality of the impactor surfaces are agitated simultaneously (this would be the impeller vanes that are agitated simultaneously)(also col. 7, line 29- col. 8, line 16)); removing a desired amount of liquid for a sample from the enclosure

Art Unit: 1743

(col. 5, line 10 – col. 6, line 45; col. 8, lines 55-62); transferring the collected samples to vials for an analyzation instrument (col. 6, lines 18-51); drying the plurality of impaction surfaces simultaneously with a flow of gas (when the fan is turned on this creates a flow of gas that would dry the impaction surfaces); coating the impactor plates with an anti-bounce coating while dry (col. 3, lines 31-40; col. 7, line 66- col. 8, line 16) (fig. 1-7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-10** are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Call et al. (USPN 6,267,016).

Call discloses a method for recovering classified particles that comprises moving a fluid that comprises a plurality of impaction surfaces (col. 4, lines 38-47; impeller vanes 24, plate 22, annular plate 26, inner surface 74 of cavity 14); supporting the

Art Unit: 1743

plurality of impactor components in a support and are enclosed (the housing 12 defines an internal cylindrical cavity 14 which encloses all the impaction surfaces and components); injecting a solvent solution into the enclosure containing an impactor surface (col. 2, line 66 – col. 3, line 8); agitating (washing) the solvent applied by moving (rocking) the support so that a plurality of the impactor surfaces are agitated simultaneously (refer to the collector and fan, which when the fan is on the (col. 7, lines 10-28) the rotational speeds which agitates the solvent applied by moving (rocking) the support (fan) so that a plurality of the impactor surfaces are agitated simultaneously (this would be the impeller vanes that are agitated simultaneously)(also col. 7, line 29- col. 8, line 16)); removing a desired amount of liquid for a sample from the enclosure (col. 5, line 10 – col. 6, line 45; col. 8, lines 55-62); transferring the collected samples to vials for an analyzation instrument (col. 6, lines 18-51); drying the plurality of impaction surfaces simultaneously with a flow of gas (when the fan is turned on this creates a flow of gas that would dry the impaction surfaces); coating the impactor plates with an anti-bounce coating while dry (col. 3, lines 31-40; col. 7, line 66- col. 8, line 16) (fig. 1-7).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel P. Siefke whose telephone number is 571-272-1262. The examiner can normally be reached on M-F 7:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sam P. Siefke



May 26, 2005


Jill Warden
Supervisory Patent Examiner
Technology Center 1700